



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,602	04/03/1998	DENNIS EDWARD SMITH	74311ACFR	2765

1333 7590 03/02/2004

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/054,602

Applicant(s)

SMITH ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11, 12, 14-21, 23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 12, 14-21, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 11, 12, 14-21, 23 & 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bagchi(U.S. 4,920,004).

Bagchi teaches polymer particles, useful as a matting agent in a photographic element, wherein said polymer particles are derived from polymers representative of the formula $-(A-x)---(B-100-x)$ wherein A represents recurring monomer units derived from carboxylic acids such as (meth)acrylic acid, itaconic acid, maleic acid, etc., B represents recurring monomer units derived from ethylenically unsaturated monomers such as styrene, divinylbenzene, etc. and "x" represents from 0.1 to 100 and preferably from 1-20 mole %. More specifically, Bagchi exemplifies a process for producing polymer particles which involves suspension polymerizing styrene(90 wt.%), methacrylic acid(5 wt.%) and divinylbenzene(5 wt.%) as a dispersed phase suspended in an aqueous phase and in the presence of sodium chloride(33 wt.%, a water-soluble inorganic salt), potassium dichromate(polymerization inhibitor), diethanolamine adipate(promoter) and SiO₂ particles(a water-insoluble particulate stabilizer Ludox AM governed by a particle size falling within the scope of the claims, as evidenced by applicants

Art Unit: 1713

disclosure at page 10, line 20). See Run 3 of Bagchi. Run 3 of Bagchi therefore anticipates the instantly claimed invention with the understanding that one of ordinary skill in the art would have readily envisaged the use of contents of methacrylic acid in amounts falling within the scope of the claims following the guidelines of Bagchi at col. 3, lines 1-24 & 42-57.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bagchi(U.S. 4,920,004) in combination with Wiley(U.S. 2,932,629).

Art Unit: 1713

The disclosure of Bagchi for what it teaches as applied to claims 1-4, 11, 12, 14-21, 23 and 26 as stated in the rejection supra. Further, the disclosure of Bagchi differs basically from the claimed invention as per the silence of a particulate stabilizer falling within the scope of the claims, viz., a water-insoluble, resinous polymer. However, Wiley teaches the use of commonly known water-insoluble polymers as particulate stabilizers in the suspension polymerization of ethylenically unsaturated monomers such as styrene. Therefore, it would have been obvious to the skilled artisan to use a commonly known particulate stabilizer in the similar such suspension polymerization procedure of Bagchi, and with a reasonable expectation of success. Criticality for such, commensurate in scope with the claims, not having been demonstrated on this record.

Response to Arguments

8. Applicant's arguments filed 12/09/03 have been fully considered but they are not persuasive.

Relative to Bagchi---The crux of Counsel's arguments appears to hinge on the carboxylic acid component content in Run 3 of Bagchi being only 5 wt.% and there being no sufficient guideposts or blazemarks for one having ordinary skill in the art to use at least 20 % by weight of carboxylic acid-containing monomer. To this end, Bagchi @ col 3, lines 17-25 & 42 - 43 teaches that monomers of the formula $-(A)_x-(B)_{100-x}-$ wherein A represents recurring units derived from monomers which include carboxylic acids(col. 3, lines 1-2) are operable at contents of from 0.1 to 100 mole % which clearly overlaps in scope with the monomer component A, a water-soluble ethylenically unsaturated monomer containing a carboxylic acid group in a concentration of from 10 % to 50 % by weight per the instant claims. One having ordinary skill in the art, following these guidelines of Bagchi, would have readily envisaged the use of the methacrylic acid component per Run 3 in contents falling within the scope of the claims without too much picking and choosing as argued by Counsel. The content of carboxylic acid monomer authorized for use in forming the suspension polymerized (co)polymers @ col. 3, line 42-43 of Bagchi clearly overlaps in scope with the carboxylic acid-containing monomer per the instant claims. Moreover, It is well established that a reference is available for all it teaches

Art Unit: 1713

including nonpreferred embodiments as for instance is discussed in M.P.E.P. § 2123, which is quoted in its entirety below (underlinings added).

2123 Rejection Over Prior Art's Broad Disclosure Instead of Preferred Embodiments

PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed

Art Unit: 1713

circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of flexibility," but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant's argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." (27 F.3d at 554, 31 USPQ2d at 1132).

Relative to Bagchi in combination with Wiley---Counsel states that Wiley will not be discussed in any detail except to state that applicants do not necessarily acquiesce to any of the statements in the Office Action referring to Wiley and reserve the right to comment latter. To this end, it is urged and maintained that the instantly claimed invention (claim 25) is obvious within the meaning of 35 USC 103(a) as per reasons stated in the Grounds of Rejection supra. Furthermore, the working Run 3 coupled with the disclosure @ col. 3, lines 42-43 clearly teaches one how to make a polymer particle containing a carboxylic acid monomer falling within the scope of the instant claims.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Art Unit: 1713

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
02.24.04